

REMARKS

Claims 83, 85, and 87 are amended. Claims 84, 86 and 88 are canceled. Claims 89 and 90 are added. Claims 1-79, 83, 85, 87, 89 and 90 are in the application for consideration.

The Specification is amended to correct a typographical error. Entry of the same is requested.

Claims 83, 85 and 87 are amended to refer to the literal language appearing in Applicant's specification. Claims 89 and 90 are added, and also refer to the literal "close-celled" language.

The Examiner asserts that Applicant's claims 83, 85 and 87 are not described in the specification in such a way as to reasonably convey that Applicant had possession of the claimed invention at the time the application was filed. Applicant disagrees and requests reconsideration.

Specifically, Applicant provides a reduction-to-practice example wherein close-celled pores are formed. The fact that Applicant discloses the specific parameters by which such are formed in the example stated material in no way limits Applicant's disclosure to the disclosed parameters and materials. The MPEP, at §2163(II)(A)(3a), indicates that possession of an invention may be shown by describing an actual reduction-to-practice of the claimed invention. Further, MPEP § 2163(II)(A)(3b) indicates that each claim must include all elements which Applicant has described as essential. Application has not described in paragraph [0043], nor elsewhere in its specification, that the parameters and other conditions upon which the Examiner relies are essential to

what Applicant recites in dependent claims 83, 85 and 87. Such are not essential, and Applicant has nowhere asserted that such are essential. Further, the undersigned has found no authority within the MPEP or elsewhere wherein an Applicant's disclosure of a reduction-to-practice example requires that an Applicant's claim be limited by all of the stated conditions and materials of that reduction-to-practice example. Clearly, as a person of skill of art would realize by reviewing Applicant's specification, process parameters and conditions could be derived which might form the pores to be substantial close-celled, open-celled, or a combination of such. Therefore, Applicant's application clearly does support that Applicant had possession of the formation of a porous oxide to have substantially close-celled pores. Accordingly, the Examiner's rejection in this regard should be withdrawn, and action to that end is requested.

The Examiner maintains the assertion that it is inherent that Werkhoven et al. results in the formation of a porous oxide because it allegedly uses the same procedure as Applicant's claim 1, and because Applicant attributes porosity to the use of remote plasma nitrogen, and that such is thereby inherent in Werkhoven et al. Again, Applicant respectfully disagrees and requests reconsideration.

It is not inherent that the processing of Werkhoven et al. would result in the formation of porous oxide, and the fact that Applicant has discovered that use of remote plasma nitrogen can so result does not make it inherent that such occurs in Werkhoven et al.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill.' Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" [Emphasis added]. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950, 1951 (Fed. Cir. 1999). The Examiner has not established that the formation of porous oxide is both a) necessarily present in the reference, and b) that such would be recognized by persons of ordinary skill. Both facets are necessary under the present state of the law, and the Examiner has not established that either is with respect to the Werkhoven et al. reference.

Further considered, even were porous oxide "necessarily" present in Werkhoven et al. (and Applicant does not assert that it is), there is absolutely no indication on the record that such would be recognized by persons of ordinary skill, in accordance with the *In re Robertson* authority. The only way such an assertion can be arrived at is using Applicant's application as the source for such alleged recognition, which is of course improper hindsight reconstruction. It is respectfully requested and asserted that the Examiner needs to show and assert why the formation of porous oxide is necessarily present in Werkhoven et al., and why or where such would be so recognized by persons of ordinary skill.

There is absolutely no disclosure or inference in Werkhoven et al. that a porous oxide is formed. Further, no porous material is shown in any of the drawings, nor is such described anywhere in Werkhoven et al. So, if any inference exists to a person of skill from Werkhoven et al., it is that the oxide formed therein is not porous. Again, even if such may have resulted, it is not necessarily present in Werkhoven et al., and would certainly not be recognized by persons of ordinary skill in the art that it was or that porosity would result.

The Examiner's response to Applicant's arguments merely relies upon a conclusion of inherency by Applicant's discovery statement in paragraph [0030] in its specification as-filed. The Examiner asserts that such language "suggests that this is an inherent property" in Werkhoven et al. However, Applicant's discovery, and broadly claiming, of something in no way means that such inherently occurs in the processing and teachings of a prior art reference. Even if such did occur in Werkhoven et al., there is no indication on the record that such would be recognized by persons of ordinary skill as required by the MPEP and the authority of *In re Robertson*. The Examiner's response to Applicant's arguments are noticeably silent of any assertion or reasoning as to why a person of skill in the art would recognize porosity occurring in Werkhoven et al. by practicing Applicant's claim 1-recited invention. If the Examiner is to persist in this rejection, it is respectfully requested that the Examiner indicate on the record how or why such would be recognized by persons of ordinary skill.

Regardless, for the foregoing reasons, it is respectfully asserted that the Examiner's anticipation rejection over Werkhoven et al. with respect to

Applicant's independent claims should be withdrawn, and action to that end is requested.

Applicant's independent claims 44 and 68 also recite the formation of porous oxide (claim 44) or porous aluminum oxide (claim 68). Such claims are rejected over Werkhoven et al. However, such reference is inapplicable for the same reasons asserted above with respect to claim 1, and the rejections thereover should be withdrawn. Action to that end is requested.

The undersigned notes that the Examiner's last Office Action was incomplete as respects examination of claims 83-88. Specifically, the undersigned notes a 35 U.S.C. §112 rejection of such claims, but no prior art rejections thereof. It is respectfully asserted that dependent claims 83, 85, 87, 89, and 90 are allowable over Werkhoven et al. on their own merits. Specifically, even if Werkhoven et al. could be concluded under the above *In re Robertson* authority to teach or inherently disclose the formation of porous oxide, it clearly does not suggest forming a porous oxide to have substantially close-celled pores. Accordingly, dependent claim 83, 85, 87, 89 and 90 should be allowed on their own merits, and action to that end is requested.

Applicant's remaining dependent claims should be allowed as depending from allowable base claims, and for their own recited features, which are neither shown nor suggested in the cited art. Action to that end is requested.

This application is believed to be in immediate condition for allowance.

Respectfully submitted,

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By: 

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